



16 MAR 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Stephen G. Kalinchak
Lundbeck Research USA, Inc.
215 College Road
Paramus, New Jersey 07652

In re Application of	:	
MARZABADI et al	:	
Application No.: 10/518,939	:	
PCT No.: PCT/US03/21348	:	
Int. Filing Date: 03 July 2003	:	DECISION
Priority Date: 03 July 2002	:	
Atty. Docket No.: 67440-A-PCT-US	:	
For: SPIROCYCLIC PIPERDINES AS	:	
MCH1 ANTAGONISTS AND...	:	

This is a decision in response to the "COMMUNICATION IN RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. §371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" filed 08 July 2005.

BACKGROUND

On 03 July 2003, applicant filed international application PCT/US03/21348 that claimed priority of an earlier United States application filed 03 July 2002. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 03 January 2005.

On 17 December 2004, applicant filed a letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a declaration of the inventors and the basic national fee of \$300 as required by 35 U.S.C. 371(c).

On 20 May 2005, the United States Patent and Trademark Office in its capacity as an Elected Office mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the declaration was defective and that applicant was required to file a new oath/declaration and a surcharge fee. The notification indicated that the second named inventor's name, Yu Jiang, does not correspond to the name set forth on the International Application and that the declaration names an additional inventor, Kim Anderson, not named in the International Application.

On 08 July 2005, applicants filed the present response which was accompanied by, *inter alia*, a declaration by Yu Jiang explaining the difference in names, and a copy of a NOTIFICATION OF THE RECORDING OF A CHANGE (Form PCT/IB/306) indicating that inventor Kim Anderson was added under PCT Rule 92*bis* to the international application.

DISCUSSION

37 CFR 1.42(a)(4) states, in part:

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92*bis*.

With respect to inventor Anderson, applicants have submitted evidence, in the form of the Form PCT/IB/306, that she was added under PCT Rule 92*bis*. As such, the declaration is acceptable with respect to inventor Anderson.

With respect to inventor Jiang, applicants have asserted, through inventor Jiang's declaration, that the inventor's legal name is Yu Jiang, that he also goes by the name Allen Jiang, and that his "legal name was incorrectly identified on the unsigned PCT Request Form as 'Allen' Jiang." Inventor Jiang goes on to indicate that on a later submitted copy of the Request his name was properly indicated as Yu Jiang. However, applicants have not submitted a showing that his name was ever officially corrected under PCT Rule 92*bis*.

In this regard, MPEP § 605.04 states, in part:

Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 37 CFR 1.182 together with an appropriate petition fee.

In that the changing of his name from "Allen" to "Yu" is more than just a typographical or transliteration error, the present request is properly treated as a petition under 37 CFR 1.182. In view of the explanation given by inventor Jiang in his declaration, on petition the acceptance of the declaration with the name Yu Jiang is deemed proper. The requisite petition fee of \$400 has been charged to counsel's Deposit Account No. 50-3201 as authorized in the present communication

CONCLUSION

For the reasons above, the petition is **GRANTED**, and the declaration filed 17 December 2004, is **ACCEPTED** for the purposes of 35 U.S.C. 371.

The application has an international filing date of 03 July 2003, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **17 December 2004**.

This application is being forwarded to the National Stage Processing Branch of the International Division for further processing in accordance with this decision.

A handwritten signature in black ink, appearing to read 'R. Cole', is positioned above the printed name.

Richard R. Cole
PCT Legal Examiner
Office of PCT Legal Administration

(571) 272-3281
Fax: (571) 273-0459